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10/021,536	10/30/2001	Chiaki Fujii	MTS-3283US	1811

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EXAMINER

SHIBRU, HELEN

ART UNIT	PAPER NUMBER
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2621

MAIL DATE	DELIVERY MODE
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06/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/021,536

Applicant(s)

FUJII ET AL.

Examiner

HELEN SHIBRU

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-21, 23-30, 32-34, 37, 40 and 43 is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-27, 33-36, 38, 39, 41 and 42 is/are rejected.
- 7) ☒ Claim(s) 22 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendments, filed 03/23/2007, have been entered and made of record. In view of the Applicant amendment, claims 22 and 31 objection is hereby withdrawn. Claims 1-43 are pending.

Response to Arguments

2. Applicant's arguments filed on 03/23/2007 have been fully considered but they are not persuasive. See the reasons sets forth below.

In re page 12 and paragraph 4 of the remarks Applicant states "Park does not disclose or suggest copying predetermined program data recorded at least in said temporary saving area to said long-term saving area.... Park does not, however, move data between a ring buffer recording area and the permanent recording area..."

In response the Examiner respectfully disagrees. Park discloses a random access storage 30 records video streams on a hard disk surface. The storage device 30 comprises temporary storing area (RAM) and permanent storing area (hard disk). The dual port for temporarily storing the digital video streams and a hard disk for permanently storing the digital video streams (see col. 4 lines 26-37). Park further discloses The video streams are recorded from the temporary storing area to the hard disk (see col. 5 lines 39-41).

The Applicant states in the same page and paragraph "The video stream in Park is moved between HDD 34 and RAM 32/Video Recovery unit 50. (col. 6 lines 28-40)" It is not clear that what the Applicant trying to point out by saying "the video stream is moved between HDD 34 and RAM 32." In Park the video stream is moved from the RAM to the disk drive to be stored

permanently, and the HDD drives the hard disk. The Examiner believes from the Applicant statement that the Applicant agreed that the video streams are moved from one of the storage areas to the other. In addition the cited columns and lines and the argument, or at least similar to the argument, could not be found in Park.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the video stream is not moved within HDD 34 (page 12 paragraph 4)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1 does not recite two different units (temporary and permanent). In addition the **random access** storage device 30 in Park records video streams in a **hard disk surface**. The storage device is one unit.

In re page 12 paragraph 3 Applicant states "Park does not disclose or suggest that the program data is copied after temporarily recording said program data in said temporary saving area until the program of said program data that is being received ends."

The Examiner respectfully disagrees. Applicant attention is directed to col. 5 lines 28-49 and fig. 6 where it shows all the video streams are recorded in RAM 32 in T_{i-1} and to HDD 34 and out put to unit 50 in T_{i+1} .

The examiner believes that the claimed invention does in fact read on the cited references for at least the reasons discussed above and as stated in the detail Office Action as follows.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-7, (11-27)/1/3, (33-34)/1/3, and 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Park (US Pat. No. 7,068,921).

Regarding claim 1, Park discloses a recording and reproducing apparatus for receiving program data including video data and/or voice data and recording and/or reproducing said program data, comprising:

a temporary saving area that is a ring buffer of temporarily recording said program data (see figures 1 and 4, col. 4 lines 30-36 and line 66-col. 5 line 6);

a long-term saving area of recording said program data for a long term (see figures 2 and 4 and col. 4 lines 30-36); and

record reproducing means of at least performing recording, reproduction or time shift reproduction of said program data in said temporary saving area and/or said long-term saving area (see col. 4 lines 7-13, lines 38-41 and lines 60-65),

wherein said record reproducing means copies predetermined program data recorded at least in said temporary saving area to said long-term saving area if said record reproducing means is instructed to record said program data for a long term when it is performing in said temporary saving area the time shift reproduction of program data that is being received (see col. 1 lines 49-51, col. 4 lines 60-65, col. 5 lines 21-49 and line 66-col. 6 line 8 and lines 16-26 and figure 5).

Art Unit: 2621

Regarding claim 2, Park discloses record reproducing means copies program data after temporarily recording said program data in said temporary saving area until the program of said program data that is being received ends (see claim 1 lines 27-30 and claim 35).

Regarding claim 3, the limitation of claim 3 can be found in claim 1. Therefore claim 3 is analyzed and rejected for the same reason as discussed in claim 1 above.

Regarding claim 4, Park discloses timing at which said record reproducing means copies said program data from said temporary saving area to said long-term saving area is performed immediately after said record reproducing means is instructed to record said program data for a long time (see col. 4 line 66-col. 5 line 13).

Regarding claim 5, Park discloses timing at which said record reproducing means copies said program data from said temporary saving area to said long-term saving area is performed immediately before said temporary saving area is overwritten and recorded (see col. 1 lines 46-62 and figs. 1, 2, and 3).

Regarding claim 6, Park discloses record reproducing means records said program data that is being received in said long-term saving area after stopping at least a recording operation with respect to said temporary saving area (see col. 2 lines 36-49).

Regarding claim 7, Park discloses predetermined program data to be copied from said temporary saving area to said long-term saving area is all or a part of program data recorded in said temporary saving area and, in case of said part of said recorded program data, said predetermined program data is data recorded in an arbitrary area on said temporary saving area (see col. 4 line 55-col. 5 line 13).

Regarding claim 11, Park discloses program data is temporarily recorded in the order of receipt in said temporary saving area (see claims 15 and 29), and said program data is temporarily recorded such that said program data can be identified from each other for each channel and/or each program on said temporary saving area (see fig. 3).

Regarding claim 12, Park discloses record reproducing means connects predetermined portions among said program data temporarily recorded in said temporary saving area based on an input from a user and copies the connected portions to said long-term saving area (see claim 9).

Regarding claim 13, Park discloses program data with said predetermined portions connected belongs to one program (see claim 9).

Regarding claim 14, Park discloses identification of said program data is defined by an EPG (Electronic Program Guide) (see col. 4 lines 8-14, col. 4 lines 66-col.5 line 6).

Regarding claim 15, Park discloses record reproducing means deletes program data recorded in said temporary saving area if any program of program data temporarily recorded in said temporary saving area (see col. 5 line 66-col. 6 line 8).

Regarding claim 16, Park discloses any program is a program that a user is currently being viewed by a user (see claim 18).

Regarding claim 17, Park discloses notifying means of notifying a user of operating contents of said recording and reproducing and reproducing apparatus (see fig. 3), wherein said notifying means notifies the user that program data recorded in said temporary saving area is to be deleted (see col. 5 line 66-col. 6 line 8).

Regarding claim 18, Park discloses an input unit for receiving an input operation from a user (see fig. 4 unit 60), wherein program data in said temporary saving area is deleted by the input operation of the user via said input unit (see col. 3 lines 12-34 and col. 5 line 66-col. 6 line 8).

Regarding claim 20, Park discloses temporary saving area has a plurality of temporary saving files (see fig. 2)

Regarding claim 21, Park discloses program data of one program is temporarily recorded in one of said temporary saving files (see fig. 5).

Regarding claim 22, Park discloses temporary saving file has temporary saving files in a number of programs that a user has viewed (see claims 1 and 9).

Claims 19 and 23 are rejected for the same reason as discussed in claim 14 above.

Regarding claim 24, Park discloses image quality changing means of changing an image quality of program data to be recorded in said temporary saving area and/or said long-term saving area (see claim 1).

Regarding claim 25, Park discloses wherein change of an image quality of program data to be recorded in said long-term saving area is for making the image quality equal to or lower than an image quality of program data temporarily recorded in said temporary saving area (see claims 32 and 35).

Regarding claim 26 wherein an image quality of said program data to be temporarily recorded in said temporary saving area is set at the highest (see col. 4 lines 25-36).

Regarding claim 27, Park discloses image quality changing means makes all image qualities of program data of an identical program to coincide with each other if an image quality varies in said program data of said identical program (see col. 4 lines 14-24).

Regarding claim 33, Park discloses ring buffer of said temporary saving area has a variable length (see claim 19).

Regarding claim 34, Park discloses ring buffer of said temporary saving area has a fixed length (see claim 3).

Claim 35 is rejected for the same reason as discussed in claim 1 above.

Regarding claim 36, Park discloses a recording and reproducing method for receiving program data including video data and/or voice data and recording and/or reproducing said program data, comprising:

a step of using a temporary saving area that is a ring buffer of temporarily recording said program data and a long-term saving area of recording said program data for a long term (see rejection of claim 1); and

a record reproducing step of at least performing recording, reproduction or time shift reproduction of said program data in said temporary saving area and/or said long-term saving area (see rejection of claim 1 above),

wherein by record reproducing means predetermined program data recorded in said temporary saving area is copied to said long-term saving area and at the same time program data that is being received other than that copied in said long-term saving area in said long-term saving area is recorded if in said record reproducing means it is instructed to record said program data for a long term when the time shift reproduction of said program data that is

Art Unit: 2621

being received in said temporary saving area is performed (see col. 1 lines 46-62 and figs. 1, 2, and 3 col. 2 lines 36-49 and rejection of claim 1).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 38-39 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park. 8.

Regarding claims 38-39 and 41-42, the limitations in claims 38-39 and 41-42 can be found in claims 1 and 3. However claims 38-39 and 41-42 further require a program for causing a computer to execute steps as claimed in claims 1 and 3. Official notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Lane by having a record medium capable of being read by a computer tangibly embodying a program causing the computer to execute the steps of the apparatus claim. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

Note to the Applicant: The USPTO considers the Applicant's "one of" language to be anticipated by any reference containing one of the subsequent corresponding elements.

Allowable Subject Matter

7. Claims 8-10, (11-21, 22)/8, (23-27)/8, 28-32, (33-34)/8, 37, 40 and 43 are allowed.

The following is an examiner's statement of reasons for allowance: The present invention is directed to a recording and reproducing apparatus for receiving program data including video data and/or voice data and recording and/or reproducing said program data. The independent claims identify the uniquely distinct feature "record reproducing means resets a predetermined portion in which said program data from a reproduction position address to a recording position address at the time of said time shift reproduction on said temporary saving area as said long-term saving area if said record reproducing means is instructed to record said program data for a long term when it is performing in said temporary saving area the time shift reproduction of program data that is being received." The closest prior arts Park et al. (US PAT NO. 7,068,921) and Tada et al (US PAT NO. 7,142,776) either singularly or in combination, fail to anticipate or render the above underlined limitations obvious.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 2621


will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru
May 25, 2007


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